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EXAMINER

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ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,625

Applicant(s)

Stein

Examiner

Rafael Perez-Gutierrez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on July 15, 2004. **Claims 1-25** are now pending in the present application. **This Action is made FINAL.**

Information Disclosure Statement

2. The information disclosure statement submitted on July 15, 2004 has been considered by the Examiner and made of record in the application file.

Drawings

3. The drawing received on July 15, 2004 is objected to as failing to comply with 37 CFR 1.84(p)(5) because it does not include the following reference numbers mentioned in the description: Reference numbers **1-6** were removed from figure 1 but they remain in the description. The Examiner respectfully suggests to the Applicant to reinsert the reference numbers in figure 1 and keep the added labels in figure 1 in order to provide clarity, precision, and consistency between figure 1 and its description in the specification. The Examiner also acknowledges Applicant's statement on page 9 of the amendment that both a replacement sheet and an annotated sheet showing changes were attached to the amendment, however, only the annotated sheet showing changes has been found in the application file. The Examiner respectfully suggests the Applicant to resubmit a new replacement sheet and a new annotated

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sheet showing changes in compliance with this paragraph and the following paragraph for consideration by the Examiner.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. If a response to the present Office Action fails to include proper drawing corrections, corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the objections/corrections to the drawings are no longer held in abeyance.

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Specification

5. The disclosure is objected to because of the following informalities:

- a) On **page 2 line 31**, replace “and-” with --and-- after “telephone,”; and
- b) On **page 3 line 9**, replace “model” with --mode-- after “this”.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a) **Claim 13** recites the limitation of “the search signal and/or response signal are encrypted” in **line 3** and the specification only provides antecedent basis for the search signal and response signal being encrypted (page 4 lines 9 and 10) and for the response signal being encrypted (page 4 lines 14 and 15 and page 6 lines 33-36). The specification does not provide antecedent basis for encrypting the search signal only. Since the “the search signal and/or response signal are encrypted” language requires that the search signal is encrypted only, the response signal is encrypted only, and the search signal and the response signal are both encrypted, it is respectfully requested that the specification be corrected to provide antecedent basis to the “the search signal is encrypted only” part of the language. This objection can be overcome by replacing “and”, in page 4 line 9, with --and/or--. For purposes of applying prior art, all three embodiments are being examined (i.e., the search signal is encrypted only, the response signal is encrypted only, and the search signal and the response signal are both

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encrypted), and

b) **Claim 19** recites the limitation of “the signal strength and/or time of reception ... is used for determining the position” in **lines 2-4** and the specification only provides antecedent basis for using both the signal strength and the time of reception for position finding (page 6 lines 26-28). The specification does not provide antecedent basis for using the signal strength only or using the time of reception only. Since the “the signal strength and/or time of reception ... is used for determining the position” language requires that the signal strength is used only, the time of reception is used is only, and both the signal strength and the time of reception are used, it is respectfully requested that the specification be corrected to provide antecedent basis to the “the signal strength is used only and the time of reception is used is only” part of the language. This objection can be overcome by replacing “and”, in page 6 line 27, with --and/or--. For purposes of applying prior art, all three embodiments are being examined (i.e., the signal strength is used only, the time of reception is used is only, and both the signal strength and the time of reception are used).

Claim Objections

7. **Claims 1, 3, 7, 8, 10, 14, 22, 23, and 25** are objected to because of the following informalities:

- a) On **line 3 of claim 1**, delete “a” after “with”;
- b) On **line 11 of claim 1**, insert --to mobile telephones-- after “signals” in order to clarify

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that the mobile telephones are in passive mode and not the base stations;

- c) On **line 12** of **claim 1**, insert --and-- after “mode”;
- d) On **line 2** of **claim 3**, replace “wherein are of the mobile telephones are” with --
wherein the at least one mobile telephone is-- before “switched”;
- e) On **line 1** of **claim 7**, replace “of claims” with --claim-- after “in”;
- f) On **line 1** of **claim 8**, replace “claims” with --claim-- after “in”;
- g) On **line 4** of **claim 8**, delete “operating” before “statuses” in order to provide proper
antecedent basis to “statuses”;
- h) On **line 9** of **claim 10**, replace “the” with --a-- before “response” in order to provide
proper antecedent basis to “response signal”;
- i) On **line 12** of **claim 10**, delete “sought” before “mobile”;
- j) On **line 3** of **claim 14**, delete “the” before “encryption” in order to provide proper
antecedent basis to “encryption codes”;
- k) On **line 2** of **claim 22**, delete “emitted” before “response” in order to provide proper
antecedent basis to “response signal”;
- l) On **line 3** of **claim 23**, replace “temperature or similar” with --or temperature-- after
“brightness,” in order to provide clarity and definiteness to the claim; and
- m) On **line 4** of **claim 25**, replace “the” with --an-- before “associated” in order to
provide proper antecedent basis to “associated home location register”.

Appropriate correction is required.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by **Hoff (WO 96/26614)**.

Consider **claims 20 and 24**, Hoff clearly shows and discloses a remote pager/cellular device 101 (mobile telephone) (figure 1) for a cellular communication system (figure 2), which device 101 (mobile telephone) can be switched to a passive mode, in which the remote pager/cellular device 101 (telephone) is not recognizable as a network subscriber (i.e., the device 101 (telephone) is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmits signals to the system, therefore, the system cannot recognize the device 101 (telephone) (also reads on claim 24 because the device 101 (telephone) is designed for use in passive mode) (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects an activation signal 211 (specific search signal) for the remote pager/cellular device 101 (mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 1-3, 9-11, 17-19, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al. (U.S. Patent # 5,485,163)** in view of **Hoff (WO 96/26614)**.

Consider **claim 1**, Singer et al. clearly show and disclose a cellular communication system (figure 1) comprising:

a plurality of communication cells 16 (only one shown) with at least one base transceiving station (BTS) 20, 22, 24 each for wireless (cordless) communication with a portable locator units (PLUs) 4; and

a home location register (HLR) 36 for registration of the portable locator units (PLUs) 4 (abstract, figure 1, column 2 lines 44-67, column 3 lines 11-17 and 34-36, and column 4 lines 4-

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6),

wherein at least one of the portable locator units (PLUs) 4 is configured to be switched to a passive mode, in which it is the PLU 4 detects an activation command (specific search signal) for the PLU 4, and transmits (emits) a location signal (response) (abstract, figure 2, column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25),

the HLR 36 has a memory (inherent) to store data about PLUs 4 in the passive mode (column 3 lines 11-17 and column 4 lines 4-6);

the BTSs 20, 22, 24 are configured to send an activation command (PLU-specific search signal) in the passive mode (abstract, figure 2, and column 4 lines 6-19); and

the HLR 36 has a control device (inherent) which is configured to initiate at least one location service (search operation) (column 3 line 56 - column 4 line 19) and determines the location (position) of the PLU 4 as a result of location (response) signals received by the BTSs 20, 22, 24 (column 4 lines 20-47).

However, Singer et al. do not specifically disclose that the PLU 4 is a mobile telephone.

In the same field of endeavor, Hoff clearly shows and discloses a remote pager/cellular device 101 (mobile telephone) (figure 1) for a cellular communication system (figure 2), which device 101 (mobile telephone) can be switched to a passive mode, in which the remote pager/cellular device 101 (telephone) is not recognizable as a network subscriber (i.e., the device 101 (telephone) is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmits signals to the system, therefore, the system cannot recognize the device 101 (telephone) (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects

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an activation signal 211 (specific search signal) for the remote pager/cellular device 101 (mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a combined mobile telephone/locator unit as taught by Hoff in the system of Singer et al. for the purpose of locating mobile telephones and provide optimal communications.

Hereinafter, the PLU 4 is being referred to as a mobile telephone.

Consider **claim 2**, Singer et al., as modified by Hoff, disclose the claimed invention as **applied to claim 1 above**, and in addition Singer et al. also disclose that the passive mode (mobile telephone 4 detects only an activation command (search signal) and then transmits a location signal (response signal) (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 6-32)) of one of the mobile telephones 4 is configured to be switched on (e.g., when a location request for the mobile telephone is started) and off (e.g., when the location request is ended) by a user by a personal identification code (PIN) (user identification code) (the PIN (user identification code) is used for accessing the location services, therefore, to access the location services and to end the location request the PIN (user identification code) must be entered) (column 3 line 65 - column 4 line 6 and column 4 lines 48-51).

Consider **claim 3**, Singer et al., as modified by Hoff, disclose the claimed invention as

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applied to claim 1 above, and in addition Singer et al. further disclose that the mobile telephone 4 is switched on (i.e., receive and transmit mode) by reception of the activation command (search signal) (column 4 lines 20 and 21).

Consider **claim 9**, Singer et al., as modified by Hoff, disclose the claimed invention **as applied to claim 1 above**, and in addition, it is inherent from the teachings of Singer et al., that the mobile telephone 4 cannot roam in the passive mode because it is not recognized as a normal network subscriber because the mobile telephone 4 is not transmitting to the network (column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25).

Consider **claims 10 and 11**, Singer et al. clearly show and disclose a method for determining the location (position) of a portable locator unit (PLU) 4 in a communication system (abstract, figures 1 and 2, column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25), comprising:

transmitting (emitting) an activation command (specific search signal) by selected base transceiving stations (BTSs) 20, 22, 24, wherein the BTSs are chosen selectively depending on the information stored in the HLR 36 (e.g., BTSs in the proximity of the HLR 36 (reads on claim 11) (column 3 lines 4-19));

receiving a location (response) signal from the PLU 4 by one or more BTSs 20, 22, 24 (column 4 lines 20-32); and

determining a location (position) area where the PLU 4 is located as a result of the received location (response) signal (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 4-32).

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However, Singer et al. do not specifically disclose that the PLU 4 is a mobile telephone.

In the same field of endeavor, Hoff clearly shows and discloses a remote pager/cellular device 101 (mobile telephone) (figure 1) for a cellular communication system (figure 2), which device 101 (mobile telephone) can be switched to a passive mode, in which the remote pager/cellular device 101 (telephone) is not recognizable as a network subscriber (i.e., the device 101 (telephone) is in a receive mode only and cellular transmitting portion 109 (figure 1) is inactive and does not transmits signals to the system, therefore, the system cannot recognize the device 101 (telephone) (abstract, page 4 lines 10-33, and page 5 lines 1-9 and 20-26)) and detects an activation signal 211 (specific search signal) for the remote pager/cellular device 101 (mobile telephone) (abstract, page 4 lines 25-33, page 8 line 20 - page 9 line 1, page 11 lines 8-17, and page 15 lines 31-37), and transmits (sends) a cellular (response) signal 213 in reply (abstract, figures 1 and 2, page 8 line 20 - page 9 line 1, page 12 line 29-33, page 13 lines 13-27, and page 15 line 31 - page 16 line 15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a combined mobile telephone/locator unit as taught by Hoff in the system of Singer et al. for the purpose of locating mobile telephones and provide optimal communications.

Hereinafter, the PLU 4 is being referred to as a mobile telephone.

Consider **claim 17**, Singer et al., as modified by Hoff, disclose the claimed invention as **applied to claim 10 above**, and in addition, it is inherent from the teachings of Singer et al., that the mobile telephone 4 cannot roam in the passive mode because it is not recognized as a normal

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network subscriber because the mobile telephone 4 is not transmitting to the network (column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25).

Consider **claim 18**, Singer et al., as modified by Hoff, disclose the claimed invention **as applied to claim 10 above**, and in addition Singer et al. also disclose that a user authorized to execute a search operation is identifiable by a personal identification code (PIN) (column 3 line 65 - column 4 line 6 and column 4 lines 48-51).

Consider **claim 19**, Singer et al., as modified by Hoff, disclose the claimed invention **as applied to claim 10 above**, and in addition Singer et al. further disclose that the signal strength and/or time of reception of the location (response) signal received from the mobile telephone 4 in one or more cells 16 is used for determining the position of the mobile telephone 4 (column 5 lines 19-47).

Consider **claim 25**, Singer et al., as modified by Hoff, disclose the claimed invention **as applied to claim 10 above**, and in addition Singer et al. also disclose that the mobile telephone 4 is switchable to a passive mode, in which it is not recognizable as a normal network subscriber (the mobile telephone 4 is not transmitting to the network), and detects only an activation command (specific search signal) for the mobile telephone 4, and then transmits (sends) a location signal (response) (abstract, figures 1 and 2, column 1 line 65 - column 2 line 3, column 2 lines 37-43, column 3 lines 47-53, and column 4 lines 4-25), and the mobile telephone 4 in the passive mode is stored in an associated home location register (HLR) 36 of the cellular communications system (column 3 lines 11-17 and column 4 lines 4-6).

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11. **Claims 4-7 and 12-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al. (U.S. Patent # 5,485,163)** in view of **Hoff (WO 96/26614)**, as applied to **claims 1 and 10 above**, and further in view of **Buchheister et al. (DE # 197 26 456 A1)**.

Consider **claims 4 and 7**, and as applied to **claim 1 above**, Singer et al., as modified by Hoff, disclose the claimed invention except that activation command (search signal) is encrypted (claim 4) and that the location signal (response) is encrypted (claim 7).

In the same field of endeavor, Buchheister et al. clearly disclose a system for locating devices (abstract) in which a first signal (search signal) used for locating a device is encrypted (reads on claim 4) (column 3 lines 44-55, column 5 lines 3-16, and claim 3) and/or a second signal (response signal) transmitted in response to a received first signal (search signal) is encrypted (reads on claim 7) (column 4 lines 5-15, column 5 lines 15 and 16, and claim 9) for security and authentication purposes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the activation command (search signal) and/or location signal (response) as taught by Buchheister et al. in the system of Singer et al., as modified by Hoff, for authentication and security purposes.

Consider **claims 5 and 6**, and as applied to **claim 1 above**, Singer et al., as modified by Hoff, disclose the claimed invention except that activation command (search signal) is pulsed (claim 5) and that the mobile telephone 4 in the passive mode allows periodic reception of the activation command (search signal) in synchronism with a pulse repetition frequency (claim 6).

In the same field of endeavor, Buchheister et al. clearly disclose a system for locating

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devices (abstract) in which a first signal (search signal) used for locating a device is pulsed (i.e., transmitted at given intervals (reads on claim 5)) (column 2 lines 47-6 and column 5 lines 41-50) and a device in a passive mode allows periodic reception of the first signal (search signal) in synchronism with a pulse repetition frequency (i.e., the device periodically wakes up at time intervals that are synchronized with the transmission time intervals of the first signal (search signal) (reads on claim 7)) (abstract, column 2 lines 27-46, column 6 lines 2-27, and claims 1 and 17) for the purpose of conserving battery power.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit the activation command (search signal) at given time intervals and allow periodic reception of said activation command (search signal) at said device as taught by Buchheister et al. in the system of Singer et al., as modified by Hoff, for the purpose of conserving battery power.

Consider **claim 12**, and **as applied to claim 10 above**, Singer et al., as modified by Hoff, disclose the claimed invention except that the search operation is performed repeatedly.

In the same field of endeavor, Buchheister et al. clearly disclose a method for locating devices (abstract) in which a location (search) operation, for a given device, is repeated at given intervals (i.e., a first signal (search signal) is transmitted at given intervals) (column 2 lines 47-6 and column 5 lines 41-50) in order to increase the probability of successfully reaching the device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the search operation repeatedly as taught by Buchheister et al.

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in the method of Singer et al., as modified by Hoff, for the purpose of increasing the probability of reaching the telephone.

Consider **claims 13 and 14**, and **as applied to claim 10 above**, Singer et al., as modified by Hoff, disclose the claimed invention except that activation command (search signal) and/or the location signal (response) are encrypted (claim 13) and that encryption codes are changed after a search operation (claim 14).

In the same field of endeavor, Buchheister et al. clearly disclose a method for locating devices (abstract) in which a first signal (search signal) used for locating a device is encrypted (column 3 lines 44-55, column 5 lines 3-16, and claim 3) and/or a second signal (response signal) transmitted in response to a received first signal (search signal) is encrypted (reads on claim 13) (column 4 lines 5-15, column 5 lines 15 and 16, and claim 9) and that specific encryption codes are used for different location (search) operations (reads on claim 14) (column 3 lines 44-55 and column 4 lines 5-15) for security and authentication purposes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the activation command (search signal) and/or location signal (response) as taught by Buchheister et al. in the method of Singer et al., as modified by Hoff, for authentication and security purposes.

Consider **claims 15 and 16**, and **as applied to claim 10 above**, Singer et al., as modified by Hoff, disclose the claimed invention except that the mobile telephone 4 in the passive mode is periodically ready to receive the activation command (search signal) (claim 15) and that the activation command (search signal) is transmitted in pulsed form (claim 16).

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In the same field of endeavor, Buchheister et al. clearly disclose a method for locating devices (abstract) in which a device in a passive mode is periodically ready to receive a first signal (search signal) (i.e., the device periodically wakes up at time intervals that are synchronized with the transmission time intervals of the first signal (search signal) (reads on claim 15)) (abstract, column 2 lines 27-46, column 6 lines 2-27, and claims 1 and 17) and in which the first signal (search signal) used for locating a device is transmitted in pulsed form (i.e., transmitted at given intervals (reads on claim 16)) (column 2 lines 47-6 and column 5 lines 41-50) for the purpose of conserving battery power in the device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to periodically receive the activation command (search signal) in the passive mode as taught by Buchheister et al. in the method of Singer et al., as modified by Hoff, for the purpose of conserving battery power.

12. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al. (U.S. Patent # 5,485,163)** in view of **Hoff (WO 96/26614)**, as applied to **claim 1 above**, and further in view of **Kass (U.S. Patent # 5,389,934)**.

Consider **claim 8**, Singer et al., as modified by Hoff, disclose the claimed invention as **applied to claim 1 above**, and in addition Singer et al. also disclose that the mobile telephone 4 has a memory for storing information (column 2 lines 37-41), however, Singer et al., as modified by Hoff, do not specifically disclose that the memory store various statuses detected by sensors and that the location (response) signal emitted by the mobile telephone transmitting information

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about the statuses stored in memory.

In the same field of endeavor, Kass clearly disclose a portable tracking system (mobile telephone) (abstract and figure 1) comprising, among other components, a memory facility 30 (figure 1) for storing various statuses detected by sensors (i.e., memory 30 stores location information as detected by the GPS unit 20 (figure 1 and column 1 lines 55-61) and temperature information as detected by sensor 120 (figure 1, column 2 lines 7-9, and claim 5)), wherein, in response to a location request, a location (response) signal emitted by the portable tracking system (mobile telephone) transmits information about the operating statuses stored by the memory 30 (e.g., the location and temperature information) (abstract, figure 1, column 1 lines 20-37 and 51-61, column 2 lines 7-42, and claims 1-3 and 5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit information about statuses stored in memory as taught by Kass in the system of Singer et al., as modified by Hoff, for the purpose of communicating supplemental information.

13. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoff (WO 96/26614)** in view of **Singer et al. (U.S. Patent # 5,485,163)**.

Consider **claim 21**, and as applied to **claim 20** above, Hoff clearly shows and discloses the claimed invention except that the passive mode can be switched on and off by a user identification code.

In the same field of endeavor, Singer et al. clearly disclose a personal locator unit (PLU)

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4 operating in a cellular communication system (figure 1) having a passive mode of operation (PLU detects only an activation command (search signal) and then transmits a location signal (response signal) (abstract, figure 2, column 1 line 65 - column 2 line 9, and column 4 lines 6-32)) that can be switched on (e.g., when a location request for the PLU is started) and off (e.g., when the location request is ended) by a personal identification code (PIN) (user identification code) (the PIN (user identification code) is used for accessing the location services, therefore, to access the location services and to end the location request the PIN (user identification code) must be entered) (column 3 line 65 - column 4 line 6 and column 4 lines 48-51).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the feature of using a PIN (user identification code) to switch the passive mode as taught by Singer et al. into the invention of Hoff in order to allowed only an authorized user or subscriber, as confirmed by the PIN (user identification number), to switch the passive mode (Singer et al.; column 3 line 65 - column 4 line 3).

14. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoff (WO 96/26614)** in view of **Singer et al. (U.S. Patent # 5,485,163)**, as applied to claim 20 above, and further in view of **Buchheister et al. (DE # 197 26 456 A1)**.

Consider **claim 22**, and as applied to claim 20 above, Singer et al., as modified by Hoff, disclose the claimed invention except that the location signal (response) is encrypted.

In the same field of endeavor, Buchheister et al. clearly disclose a system for locating devices (abstract) in which a second signal (response signal) transmitted in response to a

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received first signal (search signal) is encrypted (column 4 lines 5-15, column 5 lines 15 and 16, and claim 9) for security and authentication purposes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the location signal (response) as taught by Buchheister et al. in the mobile telephone of Singer et al., as modified by Hoff, for authentication and security purposes.

15. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hoff (WO 96/26614)** in view of **Kass (U.S. Patent # 5,389,934)**.

Consider **claim 23**, and as applied to **claim 20** above, Hoff discloses the claimed invention except that remote pager/cellular device 101 (mobile telephone) has one or more sensors for detecting noises, brightness, or temperature.

In the same field of endeavor, Kass clearly disclose a portable tracking system (mobile telephone) (abstract and figure 1) comprising, among other components, a sensor 120 for detecting temperature (figure 1, column 2 lines 7-9, and claim 5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a temperature sensor as taught by Kass in the remote pager/cellular device 101 (mobile telephone) of Hoff for the purpose of sensing ambient conditions.

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Response to Arguments

16. Applicant's arguments with respect to **claims 1-3, 10, and 11** filed on July 15, 2004 have been fully considered but they are not persuasive.

In the present application, Applicant basically argues, on page 11 of the remarks, that:

- a) Singer et al. fail to disclose use of a mobile telephone as a portable locator unit;
- b) in the invention, the user can give information immediately about his location and other conditions; and
- c) that there is not disclosure in Singer to switch the mode of the mobile telephone between an operating mode and a passive mode.

The Examiner respectfully disagrees with each of Applicant's argument.

In response to argument a) above, the Examiner notes that the rejection of claim 1 is a 103 rejection based on the combination of Singer et al. and Hoff with the main reason for combining the references being that Singer et al. do not specifically disclose that the PLU 4 is a mobile telephone. In this argument, Applicant is considering Singer et al. individually when the rejection of the claim is based on the combination. In the instant application, Hoff, as explained above, clearly overcomes the deficiency cited by the Examiner and relied upon by the Applicant in his argument. The rejection of claim 4 must be considered as a whole because the rejection is based on the combination of Singer et al. and Hoff et al. not by considering each reference individually (One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986)).

In response to Applicant's arguments b) and c) above that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., the user can give information immediately about his location and other conditions and switch the mode of the mobile telephone between an operating mode and a passive mode) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the present application, the claim language does not recite a user giving information immediately about his location and other conditions or switching between an operating mode and a passive mode.

17. Applicant's arguments with respect to **claim 20** filed on July 15, 2004 have been fully considered but they are not persuasive.

In the present application, Applicant basically argues, on page 10 last paragraph to page 11 line 2, that the device in Hoff cannot be switched from an active mode to passive mode.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., switching from an active mode to a passive mode) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In the present application, the claim language does not call from the switching to occur from an active mode to a passive mode. In fact, “active mode” is not even claimed. The current claim language specifically recites “which mobile telephone **can be** switched to a passive mode”. This limitation is a functional limitation. The device disclosed by Hoff has the necessary structure to performed the claimed functionality.

Therefore, in view of the above reasons and having addressed each of Applicant’s arguments, the previous rejection of claim 20 is maintained.

Conclusion

18. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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19. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

220 S. 20th St.
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

20. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Rafael Perez-Gutierrez', written in a cursive style.

Rafael Perez-Gutierrez

R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**
PATENT EXAMINER

October 17, 2004